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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/695,459

10/29/2003

Taro Suzuki

YTO-004

4579

20374

7590

09/15/2006

KUBOVCIK & KUBOVCIK
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EXAMINER

SCHLIENTZ, LEAH H

ART UNIT

PAPER NUMBER

1618

DATE MAILED: 09/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/695,459

Applicant(s)

SUZUKI ET AL.

Examiner

Leah Schlientz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-34 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1 – 7, drawn to an allergen inhibitor comprising an aromatic hydroxy compound, etc., classified in class 568, subclass 308.
- II. Claim 8, drawn to an allergen inhibitor comprising a phosphate, classified in class 423, subclass 304.
- III. Claims 9 and 10, drawn to an allergen inhibitor comprising aluminum sulfate, classified in class 423, subclass 556.
- IV. Claims 11 – 13, drawn to a method of inhibiting allergens comprising the step of administering an aromatic hydroxy compound, etc, classified in class 424, subclass 78.02.
- V. Claim 14, drawn to a method of inhibiting allergens comprising the step of administering an aqueous solution of aluminum sulfate, classified in class 424, subclass 600.
- VI. Claims 15 – 18 and 25 – 31 drawn to allergen-inhibiting fibers and sheets, classified in class 442, subclass 123.
- VII. Claims 19 – 24 and 32, drawn to allergen-inhibiting fibers and sheets comprising an aromatic hydroxyl compound, classified in class 442, subclass 164.
- VIII. Claim 33, drawn to an allergen-inhibiting sheet comprising a phosphate, classified in class 442, subclass 172.

- IX. Claim 34, drawn to an allergen-inhibiting sheet comprising aluminum sulfate, classified in class 442, subclass 172.

NOTE: In addition to the elected Group above, applicant is requested to elect a single species related to the allergen inhibitor. For example, a *specific* compound from the distinct group thereof as set forth in the claims (e.g. claims 1, 2, 4, 6, 7, 8, 9, 11, 12, 13, 14, etc.) to which the elected Group will be limited should be selected. The different structures included therein are a very diverse set and are independent and distinct structures, including aromatic hydroxyl compounds, heterocyclic aromatic hydroxyl compounds, divalent sulfonates having a polyoxyethylene and/or polyethylene chain, alkali metal carbonates, alum, phosphates, etc., which control the classification, thus, necessitate a specific election to which the elected Group will be drawn.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are unrelated. The inventions are shown to be unrelated if (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j). In the instant case, the claimed allergen inhibitors have a materially different design, as the aromatic hydroxy compounds, etc. of Group I have divergent chemical compositions and functions than the inorganic phosphates of Group II.

Inventions I and III are unrelated. The inventions are shown to be unrelated if (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j). In the instant case, the inventions may have a materially different design because the aromatic hydroxy compounds, etc. of Group I have divergent chemical compositions and functions than the inorganic aluminum sulfates of Group III.

Inventions I and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case, the diverse group of allergen-inhibiting compounds, as claimed, can be used for different purposes other than as an allergen inhibitor. For example, lauryl benzene sulfonate can be used as a surfactant. Additionally, an aromatic hydroxyl compound such as phenol can be used as a disinfectant, for example.

Inventions II and V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different

process of using that product. See MPEP § 806.05(h). In the instant case, a process for inhibiting allergens could be practiced with another product (i.e. pesticides, etc...).

Inventions IV and V are directed to related processes. The related inventions are distinct if the (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j). In the instant case, the methods of inhibiting allergens have a materially different design because of the various divergent allergy-inhibiting compounds that are utilized in the methods.

Inventions I-III and VI are unrelated. The inventions are shown to be unrelated if (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j). In the instant case, the inventions may have a materially different design because the allergen-inhibiting fibers of Group VI, as claimed broadly in claim 15, do not necessarily require the presence of the same allergen inhibitors claimed in Groups I-III.

Inventions I and VII are directed to related products. The related inventions are distinct if the (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j). In the instant case, the allergy

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inhibitors of Group I can have a different mode of operation than the fibers or sheets of Group VII, because the individual compounds, such as lauryl sulfate, can be used in shampoo, for example, while the fibers comprising the individual compounds can be used in clothing.

Inventions II and VIII are directed to related products. The related inventions are distinct if the (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j). In the instant case, the allergy inhibitors of Group II can have a different mode of operation than the fibers or sheets of Group VIII, because the individual compounds, such as a phosphate, can be used in detergents, for example, while the fibers comprising the individual compounds can be used in clothing.

Inventions III and IX are directed to related products. The related inventions are distinct if the (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j). In the instant case, the allergy inhibitors of Group II can have a different mode of operation than the fibers or sheets of Group VIII, because the individual compounds, such as aqueous aluminum sulfate, can be used in water purification, for example, while the fibers comprising the individual compounds can be used in clothing.

Inventions VI – IX are directed to related products. The related inventions are distinct if the (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j). In the instant case, the fibers and sheets have a materially different design because of the various divergent allergy-inhibiting compounds that are associated with the fibers and / or sheets.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

This application contains claims directed to patentably distinct species drawn to allergen inhibitors. The species are independent or distinct because of their materially different compositions which control the classification.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, the claims are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention. NOTE: This single disclosed species will name a single allergen inhibitor specifically reciting all components contained therein. An exemplified species should be elected to show clear support in the specification for the elected species.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

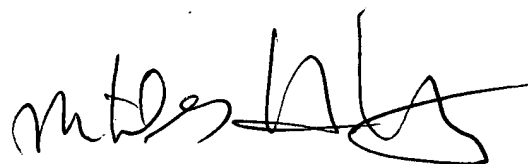
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leah Schlientz whose telephone number is 571-272-9928. The examiner can normally be reached on Monday - Friday 8 AM - 5 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hartley can be reached on 571-272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

lhs

A handwritten signature in black ink, appearing to read 'mhartley', with a stylized flourish extending from the end.

MICHAEL G. HARTLEY
SUPERVISORY PATENT EXAMINER